REMARKS

Claims 1, 41, 43, and 45 have been amended, and new claims 52 and 53 have been added. Claims 1-17 and 29-53 are now subject to examination. Support for new claims 52 and 53 is located on page 10, lines 10-15.

In the Advisory Action having a mailing date of August 21st, 2006, Applicants' Amendment After Final filed July 25th, 2006 overcame the rejections based on Lee et al. (U.S. Patent 5,744,250) and Wong (U.S. 6,399,191). However, the Examiner maintained the rejections over Kawachi et al. (U.S. 6,656,601) stating that the melt index is explicitly disclosed to be as high as 200. Claim 1 has been amended to cover grafted polyolefins having a melt index ranging from above 200 to about 5,000 g/10 min at 190°C. Applicants request that the rejection over Kawachi be removed, and the claims allowed.

In the Advisory Action, the Examiner states that Applicants' arguments regarding Godfrey et al. (U.S. 5,763,516) rest on the 132 declaration which was not timely filed and therefore not considered. Applicants hereby resubmit the 132 declaration and the arguments filed in the Amendment After Final filed July 25th, 2006 concerning Godfrey et al.

In the Final Office Action dated April 14th, 2006, the Examiner rejected claims 1-27 and 29-51 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent 5,763,516 to Godfrey et al. (hereinafter, Godfrey). To support this rejection, the Examiner states, "With re to materials such as wax which the prior art discloses but which may not be expressly recited in the claims, the term, 'consisting essentially of' only excludes those materials which materially affect the novel and basic characteristics of a composition and it is the applicants' burden to prove that such characteristics are changed by the presence of additional materials recited in a prior art product." Office Action, p. 6, ll. 1-6. Applicants assert that, in fact, the addition of wax does materially affect the novel and basic characteristics of the inventive composition and that claims 1-27 and 29-51 are not anticipated by Godfrey.

Independent claims 1, 41, 43, and 45 each recite an adhesive composition "consisting essentially of" at least one copolymer comprising repeating units from ethylene and at least one alpha-olefin, at least one tackifier resin, and at least one grafted polyolefin. The adhesive composition taught in Godfrey requires between 5 and 20 percent of a high melting, low-viscosity wax. See Godfrey, col. 7, ll. 10-13. However, Applicants submit that because the addition of a wax as taught by Godfrey materially affects the novel and basic characteristics of Applicants' adhesive composition, the claim language "consisting essentially of" distinguishes the present composition from the adhesive disclosed by Godfrey.

Applicants have enclosed herewith a Declaration Pursuant to 37 C.F.R. §1.132. The Declaration provides factual and opinion evidence that the addition of high-viscosity, low-melting waxes as taught by Godfrey materially affects the novel and basic properties of the adhesive composition claimed in the present Application. In summary, the Declaration (1) describes the making of several adhesive compositions as described and claimed in the Application with the addition of 5, 10, 15, and 20 weight percent of a high-viscosity, low-melting wax as required by Godfrey, (2) tests the onset of fiber tear, the peel adhesion failure temperature (PAFT), and the shear adhesion failure temperature (SAFT) of each wax-containing adhesive composition, (3) compares of the onset of fiber tear, PAFT, and SAFT of the wax-containing adhesives to the control adhesive (the Inventive Adhesive Composition #4 described in the Examples Section of the Application), and (4) explains that the addition of the wax according to Godfrey materially impacts the basic and novel properties of the adhesive composition described and claimed in the Application.

As evidenced by Applicants' specification and claims, onset of fiber tear, PAFT, and SAFT are basic and novel characteristics of the inventive adhesive composition. In the Examples section of the Application, Applicants test the performance of the inventive adhesive compositions by testing onset of fiber tear, PAFT, and SAFT. Applicants then compare the results of the performance tests of the inventive compositions to the onset of fiber tear, PAFT, and SAFT of other conventional adhesives. Because the onset of fiber tear, PAFT, and SAFT were used as a basis of

comparison among adhesive compositions, they are basic characteristics of the inventive adhesive. Further, because onset of fiber tear, PAFT, and SAFT were used to differentiate the inventive adhesive from the prior art, they are novel characteristics of the inventive adhesive. In addition, the Background section of the Application explains that the adhesive composition of the present invention has improved properties over prior art adhesives, including improved values for onset of fiber tear, SAFT, and PAFT. This further evidences the fact that Applicants consider onset of fiber tear, SAFT, and PAFT to be both basic and novel characteristics of the inventive adhesive.

As outlined in the enclosed Declaration under 37 C.F.R. §1.132, the addition of a high-viscosity, low-melting wax as taught in Godfrey significantly increases the onset of fiber tear and significantly decreases the PAFT and SAFT of the adhesive composition described and claimed in the Application. The elevated onset of fiber tear and depressed PAFT and SAFT indicate poorer adhesion at low and high temperatures, respectively. Because the addition of wax adversely affects the onset of fiber tear, SAFT, and PAFT of inventive adhesive composition, wax materially affects the basic and novel properties of the adhesive composition described and claimed in the Application. Therefore, Applicants assert that the "consisting essentially of" language of independent claims 1, 41, 43, and 45 differentiates Applicants' claimed adhesive from the adhesive taught in Godfrey.

In view of the foregoing, Applicants submit that claims 1-27 and 29-53 are patentable over the prior art references of record.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions, please contact the undersigned at (423) 229-6204.

No Fee is believed to be due. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment in fees to Deposit Account No. 05-0221.

Respectfully submitted,

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October 12th, 2006
Date

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Jo Ann Elam
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October 12, 2006
Date